

REMARKS

Upon entry of the instant amendment, claims 1-12 will remain pending in the instant application and stand ready for further action on the merits. Newly added claim 12 does not incorporate new matter into the application as originally filed as it finds support in original claim 1, but now recites "A modified particle (A) obtained by a process comprising a step that consists essentially of contacting the following (a), (b) and (c)...."

***Enclosed 37 CFR §1.132 Declaration***

Enclosed with this reply is a 37 CFR § 1.132 Declaration of Mr. Kazuo TAKAOKI, the instant inventor. The Examiner is respectfully requested to review Mr. TAKAOKI's declaration at this time, as it is material to a consideration of the patentability of pending claims 1-12. In this regard, the Patent Office should consider all rebuttal arguments and evidence presented by applicants, In re Soni, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Further, rebuttal evidence and arguments can be presented in the specification, Soni, 54 F.3d at 750, 34 USPQ2d at 1687, by counsel, In re Chu, 66 F.3d 292, 299, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995), or by way of an affidavit or declaration under 37 CFR § 1.132, e.g., Soni, 54 F.3d at 750, 34 USPQ2d at 1687; In re

Piasecki, 745 F.2d 1468, 1474, 223 USPQ 785, 789-90 (Fed. Cir. 1984).

**Claim Rejections - 35 USC § 102(a)/102(e)**

Claims 1-11 have been rejected under the provisions of 35 USC § 102(e) as being anticipated by Ogane US 2002/0143124 (US '124). Claims 1-11 have also been rejected under the provisions of 35 USC § 102(a) as being anticipated by Ogane DE 101 64 188 (DE '188). Reconsideration and withdraw of each of these rejections is respectfully requested based on the following considerations.

Anticipation - Legal Standard

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Distinctions Over Ogane US '124

In the producing process of the modified particle used in US '124 of Ogane, there is disclosed as an essential component the use of a compound (c) such as water [see paragraph [0069] of the US '124 disclosure], namely a compound represented by the following general formula [3]:



(in the above formula [3],  $R^2$  represents a hydrocarbon group or a halogenated hydrocarbon group; T represents, independent of each other, an atom in the groups XV or XVI in the Periodic Table, and t represents a valence of T in respective compounds), is an essential component.

On the other hand, in claim 1 of the instant application, the use of a compound (c) such as water is excluded. See component (b);  $R^1_{t-n}TH_n$  [2], in the instant claim 1, wherein water is positively excluded from the scope of formula [2]. In other words, though water corresponds to  $t = n = 2$ ,  $n = 2$  is excluded from formula [2].

Therefore, the catalyst component (A) in the instant claim 1 is clearly different from the catalyst component disclosed in Ogane US '124.

Further, as a catalyst for polymerization of an addition monomer, when a compound (c) such as water is not used for preparation of the modified particles, the obtained modified

particles show an excellent effect on a polymerization activity of the catalyst prepared by contacting the catalyst components (A) (the modified particle), (B) (a transition metal compound) and (C) (an organoaluminum compound), together.

In support of the above contention, the Applicant submits a 37 CFR § 1.132 declaration of Mr. Kazuo TAKAOKI to prove and evidence that a catalyst using a modified particle prepared without using a compound (c) such as water is excellent in a polymerization activity, when compared with that using a modified particle prepared using the compound (c).

As apparent from Mr. Takaoki's declaration, a catalyst using the modified particle prepared without using the compound (c) in US 2002/0143124, is higher in polymerization activity than the catalyst disclosed in US 2002/0143124 of Ogane. Such results were not previously expected.

Therefore, the claimed invention is not anticipated by US '024 of Ogane and is not rendered obvious thereby.

Distinctions Over Ogane DE '188

Since DE 10164188A1 is a counter-part of US 2002/0143124, it also follows that the instantly claimed invention is not anticipated by DE 10164188A1 in view of the reasons described above, and is further not rendered obvious thereby. For example, DE 10164188A1

does not provide any motivation to those of ordinary skill in the art to exclude its component (c), such as water.

Additional Considerations

As indicated above, claim 12 has been added herein, with the same reciting "A modified particle (A) obtained by a process comprising a step that *consists essentially of* contacting the following (a), (b) and (c)..." (*emphasis added*).

Accordingly, it is submitted that claim 12 is also patentable over each of the cited art references for the reasons mentioned above, and for the additional reason that the cited art completely fails to teach or otherwise for the invention of claim 12, and also completely fails to provide any motivation to those of ordinary skill in the art that would allow them to arrive at the invention of claim 12, which recites the presence of a step that *consists essentially of* contacting (a), (b) and (c) as recited in the claim.

CONCLUSION

Based on the remarks submitted herein, and the comparative testing set forth in Mr. TAKAOKI's enclosed 37 CFR § 1.132 Declaration, the Examiner is respectfully requested to reconsider and withdraw each of the outstanding rejections of record, and to issue a Notice of Allowance, clearly indicating that each of pending

claims 1-12 is allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Enclosure: 37 CFR § 1.132 Declaration of Mr. Kazuo TAKAOKI